

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/685,447

**REMARKS**

Claims 5-9 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 11, 13-15 and 18 of copending Appln. No. 10/291,650.

Applicants traverse, and respectfully request the Examiner to reconsider for the following reasons.

As claimed in independent claim 5, the present invention relates to a method for producing a highly branched perfluoroolefin. The claimed method comprises reacting a hexafluoropropene trimer with a trialkylperfluoroalkylsilane.

On the other hand, the claims of copending Appln. No. 10/291,650 relate to a method of providing a low-molecular radical. The method of the copending application comprises a super-stable radical generating reaction and a radical releasing reaction (see claim 1 of the co-pending application). The super-stable radical generating reaction comprises introducing a low-molecular-pre-radical group into a radical-carrying molecule such as a hexafluoropropene trimer (see claims 2 and 11 of copending Appln. No. 10/291,650).

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? In this regard, a reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the reference application. See MPEP §804 (pg. 800-20, August 2001).

As applied herein, the method of the present invention does not include a super-stable radical generating reaction as required by the claims of copending Appln. No. 10/291,650.

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Therefore, claims 5-9 of the present application do not claim the same invention as that of the copending application.

More particularly, the claims of the copending application are directed to providing a low-molecular radical, whereas the present claims are not. Namely, generating a super-stable perfluoroalkyl radical is not required by present claims 5-9. As such, producing a highly branched perfluoroolefin of formula (1) according to present claims 5-9 would not literally infringe the claims of the copending application which require producing a low-molecular radical.

Consequently, it is respectfully submitted that claims 5-9 of the present invention define an invention different from that of claims 11, 13-15 and 18 of copending Appln. No. 10/291,650, and withdrawal of the foregoing rejection under 35 U.S.C. § 101 is respectfully requested.

Withdrawal of all rejections and allowance of claims 5-9 is earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance the prosecution of this application, the Examiner is invited to contact the undersigned at the local Washington, D.C. telephone number indicated below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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